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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,833	06/21/2001	Robert Sesek	10006174-1	7851

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Intellectual Property Administration  
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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,833

Applicant(s)

SESEK, ROBERT

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-15,18,19 and 23-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-15,18,19 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Application History*

1. This action is responsive to the Request for Continued Examination, filed on 4/7/2005.
2. Applicant has cancelled claim 2, and amended claims 1, 4, 18 and 23.
3. Claims 1, 3-7, 9-15, 18, 19, and 23-25 are pending in the case, claims 1, 7, 12, 15, 19 and 23 are independent claims.
4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action (dated 12/2/2004) has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/7/2005 has been entered.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."*

6. Claims 1, 3-7, 9, 10, 12, 13, 15, 18, 19, and 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads US Patent publication 2002/0142765, filed 3/30/2001, published 10/3/2002.

7. **Regarding independent claim 1**, Roads discloses sending an electronic document from an electronic document sender to an electronic document receiver having an electronic address. Rhoads recites: *"Although one embodiment comprises a network appliance, any network device can be used, e.g., a server, a printer, a copier or a facsimile machine"* (page 2, paragraph 25). A facsimile machine is well known in the art as an electronic document sending device that sends an electronic document to an electronic document receiver (i.e. another facsimile machine) having an electronic address.

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Rhoads discloses electronically obtaining an electronic address of an electronic document receiver, via wireless communication, from an address book stored in a mobile computing device. Rhoads recites: "*FIG. 2b is a block diagram of one embodiment of a network appliance (e.g., a rack-mounted appliance) capable of receiving IR signals containing configuration information (e.g., an IP address) from a wireless device*" (page 2, paragraph 18).

8. **Regarding dependent claim 3**, Rhoads discloses the electronic document sender as a digital sender. Rhoads recites: "*Although one embodiment comprises a network appliance, any network device can be used, e.g., a server, a printer, a copier or a facsimile machine*" (page 2, paragraph 25). A facsimile machine is well known in the art as a digital sender.
9. **Regarding dependent claim 4**, Rhoads discloses the mobile computing device as a personal digital assistant. Rhoads recites: "*Wireless device 102 may be any device capable of generating, encoding and transmitting IR signals. In one embodiment, wireless device 102 is a personal digital assistant (PDA)*" (page 2, paragraph 26).
10. **Regarding dependent claim 5**, Rhoads discloses an electronic document receiver as a facsimile machine. Rhoads recites: "*Although one embodiment comprises a network appliance, any network device can be used, e.g., a*

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*server, a printer, a copier or a facsimile machine*" (page 2, paragraph 25). A facsimile machine is well known in the art as electronic document receiver.

11. **Regarding dependent claim 6**, Rhoads discloses the electronic address as a network address. Rhoads recites: *"FIG. 2b is a block diagram of one embodiment of a network appliance (e.g., a rack-mounted appliance) capable of receiving IR signals containing configuration information (e.g., an IP address) from a wireless device"* (page 2, paragraph 18).
12. **Regarding independent claim 7**, the claim contains substantially the same subject matter as claim 1, and is rejected using the same rationale.
13. **Regarding dependent claim 9**, Rhoads discloses a facsimile machine (as described above), which is well known in the art to image a paper document.
14. **Regarding dependent claim 10**, Rhoads discloses storing the electronic address within the electronic document sender. Rhoads recites: *"Finally, the configuration information is stored in the appliance's memory"* (page 1, paragraph 16).
15. **Regarding independent claim 12**, the claim is directed toward a device for the method of claims 1 and 9 combined, and is rejected using the same rationale.

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16. **Regarding dependent claim 13**, the claim is directed toward a device for the method of claim 5, and is rejected using the same rationale.
17. **Regarding independent claim 15**, the claim is directed toward a system for the method of claim 1, and is rejected using the same rationale.
18. **Regarding dependent claim 18**, Rhoads discloses maintaining an address book of addresses. Rhoads recites: *"A PDA is a small mobile hand-held device that provides computing and information storage and retrieval capabilities for personal or business use. Most PDA's which are often used to provide immediate access to appointment and address book information"* (page 2, paragraph 26).
19. **Regarding independent claim 19**, the claim is directed toward a device for the device of claims 12 and 18 combined, and is rejected using the same rationale.
20. **Regarding independent claim 23**, the claim is directed toward computer readable medium for the method of claim 7, and is rejected using the same rationale.
21. **Regarding dependent claim 24**, the claim is directed toward computer readable medium for the method of claim 1, and is rejected using the same rationale.

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22. **Regarding dependent claim 25**, the claim is directed toward computer readable medium for the method of claim 9, and is rejected using the same rationale.



***Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 902 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

24. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads in view of Hattori et al. US Patent 6,512,599, filed 1/19/1999, patented 1/28/2003.

25. **Regarding dependent claim 11**, Rhoads discloses sending documents with addresses imported from mobile computing devices as described above. Murphy fails to disclose erasing transmission data after transmission of the document. Hattori teaches erasing transmission data after transmission of the document. Hattori recites: *"During the fax to print and send function, the fax transmission data is deleted after the fax transmission data is printed and transmitted"* (column 40, lines 9-11)

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Rhoads' document sending method with the transmission data eraser process of Hattori because: *"the fax transmission data is deleted after it has been transmitted, the memory region*

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*of the RAM 63 or 64, which stores the fax transmission data, can be effectively used"* (Hattori, column 40, lines 12-15)

26. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads in view of Besprosvan. US Publication 2002/0124057, filed 3/5/2001, published 9/5/2002.

27. **Regarding dependent claim 14**, Rhoads discloses a document-sending device with addresses imported from mobile computing devices as described above. Murphy fails to disclose the use of a distribution list. Besprosvan teaches the use of a distribution list. Besprosvan recites: *"The sixth operational feature relating to Web browser access respecting the address book is "group lists." The user is able to create group distribution lists. Group lists allow for message distribution to selected fax and/or e-mail entries in the group"* (page 6, paragraph 84).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to combine Rhoads' document sending with the distribution list as taught by Besprosvan, in order to provide *"a unified communications system to integrate telephone, facsimile, and e-mail communications, as well as communications through document dissemination and video or other digital communication technique"* (Besprosvan, page 1, paragraph 1).

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***Response to Arguments***

28. Applicant's arguments with respect to claims 1, 3-7, 9-15, 18, 19, and 23-25 have been considered but are moot in view of the new ground(s) of rejection, described above.

***Conclusion***

29. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

<u>Publication</u>	<u>Date</u>	<u>Inventor</u>
• US-2002/0073217	06-2002	Ma et al.
• US-2002/0073234	06-2002	Ma, David Yin-Shur
• US-2002/0076004	06-2002	Brockenbrough et al.
• US-2002/0076015	06-2002	Norwitz et al.
• US-2002/0087651	07-2002	Uhlmann, Gregory John
• US-2002/0116477	08-2002	Somashekar et al.
• US-2002/0152332	10-2002	Rensin et al.
• US-2002/0165894	11-2002	Kashani, Mehdi
• US-2002/0165932	11-2002	Rensin et al.
• US-2002/0181442	12-2002	Rajani, Purshotam

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn  
June 14, 2005

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
6/17/2005